

REMARKS

Status of the Claims

Claims 32-42, 44-48, and 51-63 pending. Claims 32, 40, 42, 58, 60 and 61 are amended.

Filing Date

The cover sheet for the Office Action still lists the filing date of the instant application as June 26, 2001.

In fact, the filing date for this application is June 25, 2001.

A petition to correct the filing date was filed January 31, 2002. This petition was granted. A copy of the letter indicating that the petition was granted is enclosed for the convenience of the Examiner.

The Examiner is respectfully requested to correct the bibliographic data to reflect the correct filing date.

Restriction Requirement

In the Office Action dated September 29, 2003, the Examiner issued a Restriction Requirement, which divided the application into two Groups:

Group I directed to the methods of claims 32-42, 44-48, 51, and 52; and

Group II, directed to the methods of claims 53-63.

This Restriction Requirement is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Restriction Requirement alleges that the methods are patentably distinct, but offers no subjective support for this proposition.

In order to properly issue a Restriction Requirement, the burden is on the Examiner to show two criteria: (i) the Application claims independent or distinct inventions, as required by both § 121 and USPTO rules, and (ii) the Examiner must show that examining all the claims inventions in a single application would constitute a serious burden. See MPEP § 803.

In the instant case, there is no showing that the inventions are independent and distinct. Along these lines, there is no indication in the Office Action that the inventions are each classified differently and would require an undue amount of additional searching.

With respect to the second requirement, there is no indication that any additional searching or consideration (if in fact there is any) would be undue. On the contrary, the pyrimidine compounds, which are central to the claimed methods, and are believed to control classification, overlap. For example, Formula 4 is present in claim 32 (Part of Group I) and claim 53 (part of Group II). The Office Action provides no reasons or objective evidence on the record to substantiate either a separate classification, separate status in the art, or different field of search for the separate inventions.

In summary, since there is no indication that the Groups II and I are independent and distinct from one another, and since there is no indication that there would be any undue burden on the Examiner in the absence of this Restriction, it is clear that the Restriction Requirement in this case is improper. As such, Applicants respectfully request that the Restriction Requirement be withdrawn.

Finally, the Examiner is respectfully reminded that in the Office Action mailed September 19, 2002, a four-way Restriction Requirement was made. In order to expedite the prosecution of the Application, Applicants cancelled the non-elected claims in the Amendment that followed.

Issues Under 35 U.S.C. § 103

As stated in the Office Action, there are no remaining prior art issues under 35 U.S.C. § 103.

Issues Under 35 U.S.C. § 112, First Paragraph

Claims 40 and 42 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested. However, this rejection is based on “inconsistencies” in the Formula designated as “Formula 4” in the Specification and the Claims. In view of the above amendment, this rejection is moot.

The compounds of claims 40 and 42 are no longer designated as “Formula 4,” but are clearly properly dependent from claim 35 are definite and are supported by the Specification. (See the Specification at pages 18 and 23). Furthermore, the substituents as claimed actually remedy inconsistencies between Formula 4 and Formula 9 (clearly a preferred compound of Formula 4, see the Specification at page 20).

Claims 32-42, 44-48, 51, and 52 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested. However, this rejection is moot in view of the above amendment to Claim 32. This amendment has clear support in the Specification, including the representative examples and data presented therein. Claim 33-42, 44-48, 51 and 52 are dependent from Claim 32.

In view of the above, Applicants' respectfully request that these rejections be withdrawn.

Finality of Office Action

Applicants' respectfully that this Office Action was improperly made final. The Office Action states that "Applicant's amendment necessitated the new ground(s) of rejection presented in the Office Action." However, this is not accurate.

Applicants' previous amendments to claim 40 and 42 corrected a typographical error in the formula (adding a double bond to the pyrimidine ring). The issues raised in the "new" rejection are (1) Formula 9 substituents and (2) "method of inhibiting oxidation" language. These issues did not necessitate the new grounds of rejection presented in the outstanding office action. In fact, the features of the claims that are now at issue in the new rejection were presented in the Amendment filed December 18, 2002.

MPEP § 706.07 states that "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant...The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut

off in the prosecution of his or her application.” As stated above, the features of the claims that are now at issue in the new rejection could not have necessitated the new grounds of rejection because the were presented in a previous amendment.

Therefore, it is clear that the Office Action was improperly made final. In the event that the present Amendment does not result in the immediate allowance of the Application, Applicants’ respectfully submit that the finality of this office action be removed.

Petition for an Extension of Time

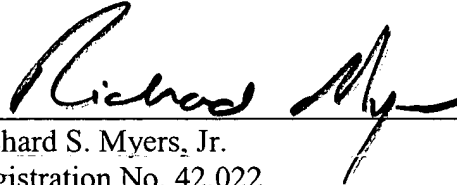
Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for an extension of one month to July 7, 2003 (Monday) for the period in which to file a response to the outstanding Office Action. The required fee of \$55.00 is attached hereto.

The Commissioner is authorized to charge any deficiency or credit any overpayment associated with this amendment to Deposit Account 50-2752.

From the foregoing, further and favorable reconsideration is requested in the form of a Notice of Allowance and such action is believed to be in order.

If the Examiner has any questions concerning this Response or the Application in general, she is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard Myers", is written over a horizontal line.

Richard S. Myers, Jr.
Registration No. 42,022
STITES & HARBISON
Customer No. 32885
615-244-5200

Attorneys for Applicant